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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Markku VERKAMA et al.

Art Unit: 2663

Application No.: 09/510,893

Examiner: Min JUNG

Filed: February 23, 2000

Attorney Dkt. No.: 59643.00087

For: MANAGEMENT OF PACKET SWITCHED CONNECTIONS IN A MOBILE COMMUNICATIONS NETWORK

PETITION UNDER 37 C.F.R. § 1.182

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

October 17, 2003

Sir:

Applicants petition under 37 C.F.R. §1.182 to substitute the current Specification of the above-captioned U.S. Patent Application (a U.S. Continuation Application) with a new Specification that is an English-language translation of the Finnish-language Specification of the PCT Application (PCT/FI99/00564) which is the parent of the above-captioned U.S. Continuation Application. An explanation of why this Petition has been filed is provided below, along with reasons why this Petition should be granted.

A Declaration that details the circumstances surrounding the filing of the present Petition is attached hereto. Also attached are a true and verified Translation of the Finnish-

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language PCT Application and a check in an amount equal to the fee for the filing of this Petition.

Background

As discussed in the attached Declaration by Ms. Sirpa Kuisma, a European Patent Attorney who is fluent in both Finnish and English, Applicants have filed the present Petition because, after comparing the Specification of the above-captioned U.S. Continuation Application with the above-referenced Finnish-language PCT Application, Applicants discovered some inconsistency between the two documents. The Declaration also discusses why the inconsistency is present, and explains why the Specification of the true and verified Translation, attached hereto, should be substituted for the current Specification.

As detailed in the attached Declaration, Ms. Kuisma's European law firm recently took over the responsibilities of the Applications discussed herein from a previous agent of the Assignee of these Applications. When reviewing the file of the PCT application, Ms. Kuisma discovered that the previous agent had filed a Finnish Application (FI981485) on June 26, 1998. Ms. Kuisma also discovered that, on June 24, 1999, the previous agent had filed a PCT Application, in Finnish, in the Finnish Patent Office acting as the Receiving Office, claiming priority from the Finnish Patent Application. Ms. Kuisma then discovered that the previous agent had filed an English translation of the PCT Application in the Swedish Patent Office acting as the International Search Authority on August 26, 1999.

When Ms. Kuisma compared the English translation filed with the Swedish Patent Office and the Finnish-language PCT Application, she found that the subject matter contained in these two documents was not identical. Rather, the subject matter in the English

translation corresponded to the subject matter previously contained in the Finnish Patent Application, rather than the PCT Application.

As explained in the attached Declaration, it appears as though the translator who prepared the English translation filed on August 26, 1999 had not been made aware by the previous agent that the Finnish Patent Application was not identical to the Finnish-language PCT Application. Hence, the translator prepared a translation of the Finnish Patent Application rather than of the PCT Application. This has resulted in the current Specification of the above-captioned U.S. Continuation Application being inconsistent with the Specification of the PCT Application.

In order to correct this situation, Ms. Kuisma, a European Patent Attorney who is, as mentioned above, fluent in both English and Finnish, has prepared and verified the Translation attached hereto. The attached Translation is of the Finnish-language PCT Application discussed above, and not of the Finnish Patent Application. Applicants request that the attached Translation be entered as a Substitute Specification in the above-captioned U.S. Continuation Application.

Reasons for Granting the Present Petition

Applicants respectfully submit that the present Petition should be granted. In other words, Applicants respectfully submit that they should be allowed to substitute the Specification included in the Translation attached hereto for the current Specification of the above-captioned U.S. Continuation Application. Reasons for granting this Petition are provided below.

First, Applicants respectfully submit that it is clear from the prosecution history of the U.S. Continuation Application that it was Applicants' intent to file a translation of the Finnish-language PCT Application, not of the Finnish Patent Application, in the U.S. This intent is particularly clear in view of the fact that, on February 23, 2000, a Request for Continuation of an International Application Under 37 C.F.R. §1.53(b) had been filed with the U.S. Patent Office, listing PCT/FI99/00564, rather than the Finnish Patent Application, as the parent Application.

Next, Applicants respectfully submit that the filing of a translation of the wrong document was purely the result of a clerical error, having no deceptive intent associated therewith. As discussed in the attached Declaration, and as shown in the attached Translation, only a small portion of the text in the Finnish Patent Application was modified to generate the Finnish-language PCT Application. Therefore, an administrative oversight by Applicants' previous agent explains why an error was made. Applicants point out, however, that upon having discovered the error, Applicants' current representatives have acted diligently in attempting to correct it.

In addition to the above, Applicants point out that the Finnish-language PCT Application was filed with the Finnish Patent Office, an internationally-recognized entity that granted Applicants an internationally-recognized filing date. Further, Applicants point out that public access to the Finnish-language PCT Application is available at the International Bureau under PCT Rule 94.1(b). Hence, a verifiable and credible record exists of what subject matter Applicants originally attempted to protect in the PCT Application and of when protection for this subject matter was first sought. Therefore, Applicants respectfully submit

that they are not presently attempting to add subject matter that was not previously disclosed in the documents upon which the present U.S. Continuation Application claims priority. Rather, Applicants are merely attempting to incorporate subject matter into the present U.S. Continuation Application that should have been included therein from the outset.

Lastly, Applicants point out that, under 35 U.S.C. §371(c), “[a]n international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office”. At least in view of this section of the Code, Applicants respectfully submit that, in the case at hand, the above-discussed Finnish-language PCT Application effectively became the U.S. Continuation Application. Hence, correcting the Specification of the U.S. Continuation Application using the attached Translation does not constitute the addition of new matter. Rather, the subject matter being added as part of the correction has been a part of the present U.S. Continuation Application from the outset, simply in a different language.

Conclusions

Applicants have supported that, from the outset, the subject matter contained in the attached Translation is what Applicants intended to file as the U.S. Continuation Application discussed herein. Applicants have also supported that the present Petition has been filed pursuant to the detection of a clerical error that involved no deceptive intent. Further, Applicants have shown that, under 35 U.S.C. §371(c), all of the information contained in the attached Translation is already part of the U.S. Continuation Application, just in a different language.

Even further, Applicants have pointed out that an internationally-recognized and highly credible entity, namely, the International Bureau, has available records supporting the fact that the attached Translation contains no subject matter that was not previously included in the Finnish-language PCT Application. Therefore, at least for the reasons discussed above, Applicants respectfully request that the present Petition be granted and that the Specification portion of the attached Translation of the Finnish-language PCT Application be substituted for the present Specification.

The filing of this petition and the supporting declaration was discussed with Mr. Paul Bell of the PCT legal office. Mr. Bell's assistance is greatly appreciated.

Enclosed is a check in the amount of one-hundred-and-thirty dollars (\$130.00) to cover the cost of the petition fee. In the event that this check is found to be insufficient, or if any additional fees are due with respect to the filing of this paper, please charge Counsel's Deposit Account Number 50-2222.

Respectfully submitted,

SIGNATURE ON ORIGINAL

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Enclosures: Check No. 010569 in the amount of \$130.00
Declaration Supporting Petition Under 37 C.F.R. § 1.182
Verified Translation